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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,535

Applicant(s)

Vial

Examiner

Kathleen J. Prunner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 16, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-17, 19, 20, and 22-26 is/are rejected.
- 7) ☒ Claim(s) 14, 18, 21, and 27 is/are objected to.
- 8) ☒ Claims 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 13, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, (A) the “thread” element, i.e., the element having threads, as called for by claim 6; (B) the insertion of the tip device “into said shaft from the rear end thereof”, as called for by claim 11; (C) the “tip” being “symmetrical with respect to a cone axis”, as called for by claim 13; (D) the “terminal part” being “rotatably received in said shaft end”, as called for by claim 14; (E) the “thread element having an inclination angle”, i.e., the element having threads and having an inclination angle, as called for by claim 14; (F) the terminal part being “provided with an inclined surface at its front end for one of controlling and adjusting a longitudinal movement of said refilling device”, as called for by claim 14; (G) the two web portions extending to form an angle (β) between 160° and 180° , as called for by claim 17; (H) the “terminal part” being “rotatably received in said shaft”, as called for by claim 18; and (I) “means for permitting an opening of said writing instrument to exchange said refilling device”, as called for by claim 26, must be shown or the features canceled from the claims. No new matter should be introduced or it will not be entered.

A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. ^{drop} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) **mentioned** in the description: “x” (note page 11, line 6).

A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) **not mentioned** in the description: (A) ^{drop} **28** (note Fig. 2b);

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- * ^{keep} (B) **50b** (note Figs. 1a, 1b, 1c and 5, illustration "B"); ^{keep} (C) **41a** (note Figs. 7a and 7b); and ^{keep} (D) **26** (note Figs. 7a and 7c). A proposed drawing correction or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. ^{keep} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "41" and "42" have both been used to designate the same channel portion (note Figs. 2a, 2b, 7a, 7b, 7c, 7d, 8a and 8b). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. ^{keep} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "y₁" and "27" have both been used to designate a distance (note Fig. 8b). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
6. ^{drop} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "21" has been used to designate both front guiding protrusions (note Figs. 1b and 4) and a groove (note Fig. 6). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
7. ^{drop} The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both front guiding protrusions (note Fig. 4) and a web (note Fig. 6). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34" has been used to designate both an inner part (note Fig. 7a and lines 36-37 on page 13) and a shoulder (note line 10 on page 14). A proposed drawing correction or amendment to the

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specification to correct the description is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

9. The drawings are objected to because: (A) the description given on page 8 for Figs. 1, 2, 6, 7 and 8 fails to correspond with what is shown in the drawings, e.g., there is no "Figure 1" but there is Figs. 1a, 1b and 1c, etc., etc.; (B) Figs. 3 and 4 contain four different views which should be labeled separately, e.g., in a manner similar to that shown on pages 1 and 2 of the drawings; and (C) Fig. 5 contains five different views which should be labeled separately. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of the drawing to cure defects **MUST** be embodied in a **SEPARATE LETTER to the Draftsman**. See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

Specification

11. The spacing of the lines of the specification is such as to make entry of amendments impossible. New application papers with lines double spaced on good quality paper are required.

12. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, **each of the lettered items should appear in upper case, without**

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underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

13. **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.

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- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Reference to a "Microfiche Appendix": See 37CFR 1.96(c) and MPEP § 608.05, if the application was filed before March 1, 2001. The total number of microfiche and the total number of frames should be specified. Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc and an incorporation by reference of the material on the compact disc.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole.

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The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (I) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet (37 CFR 1.52(b)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(I)-(p).

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- (j) Abstract of the Disclosure: A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims.
- (k) Drawings: See 37 CFR 1.81, 1.83-1.85, and MPEP § 608.02.
- (l) Sequence Listing, if on paper: See 37 CFR 1.821-1.825.

14. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

15. The disclosure is objected to because of the following informalities: (A) the specification is not in the proper format since it does not contain section headings; and (B) on page 1, the title of the invention should be centered on the page and at least the first letter of each word should be in cap format. Appropriate correction is required.

16. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The claimed subject matter which lacks such antecedent basis is as follows: (A) the tip having “an elongated extension” with “the length of said tip being larger than a diameter at the rear end of said tip, particularly more than one and a half times as large”, as called for by claim 12; (B) the “tip device . . . of an elongated shape”, as called for by claim 15; (C) the “cone axis being variable in its angle relative to said main axis”, as called for by claim 15; (D) the “tip device comprises a rear end portion”, as called for by claim 16; (E) the “rear end portion cooperating with a shoulder portion of a particularly integral refilling device for providing a contour control for the change of inclination of said tip device”, as called for by claim 16; (F) the “control means comprising at least one, particularly two laterally spaced web segments, one of them comprising two web portions extending to form an angle of less than 180°, particularly between 160° and 180°, for controlling the inclination of said tip device”, as called for

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by claim 17; (G) the “terminal part of the shaft is rotatably received in said shaft, particularly being one of hardly turnable”, as called for by claim 18; (H) the “circumferential lock-in positions”, as called for by claim 18; (I) “the kink angle of said web portions substantially corresponds to a maximum inclination angle of said tip device relative to said main axis”, as called for by claim 19; (J) the “tip device is provided with at least one coupling means at its backwards facing end portion”, as called for by claim 20; (K) the “shoulder or step of said refilling device being coupled to said coupling means for applying forces on said tip” with “said forces controlling the inclination of said tip device”, as called for by claim 20; (L) “a first elastic force acts on said refilling device by an axially acting spring means for axially pretensioning said refilling device one of towards said tip and away from said tip”, as called for by claim 21; (M) “one of said dividing position being located close to said terminating part of said shaft and said dividing position being located close to said tip device”, as called for by claim 22; (N) the “length of one of said shaft and said writing instrument being varied upon or for varying said inclination angle of said tip device”, as called for by claim 23; (O) the “refilling device being tensioned by a compression spring such that said refilling device is urged against said tip”, as called for by claim 24; (P) the “compression spring being dimensioned such that it receives/absorbs writing forces without substantially changing the position of said refilling device but effects a smaller torque on the tip than a returning force of a further elastic means”, as called for by claim 24; (Q) the “further elastic means . . . being also coupled to said tip to allow it to be pivoted back into a straight position with respect to said main axis”, as called for by claim 24; (R) the “refilling device being elastically tensioned by a pressure spring in relation to said tip”, as called for by claim 25; (S) “a second elastic force being applied such on said tip and dimensioned such that a torque applied by said compression spring is at least compensated”, as called for by claim 25; (T) “means for controlling and adjusting said inclination angle of said tip”, as called for by claim 26; (U) “further means for permitting an opening of said writing instrument

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to exchange said refilling device”, as called for by claim 26; (V) “means connected to said tip device . . . for directly controlling, particularly adjusting, varying and returning the inclination angle of said tip device”, as called for by claim 27; and (W) the “control being effected by or starting out from said shaft”, as called for by claim 27. Correction is required.

17. The following informalities in the specification are noted: (A) reference signs 9, 9a, 9b, 10, 13, 14, 21, 22, 23, 40, 41, 42, 43 and y_1 are inconsistently described in the specification on pages 8-14; (B) on page 1, line 5, a comma should be inserted after “e.”; (C) on page 1, line 6, --a-- should be inserted after “as”; (D) on page 1, line 7, “comprised” should be changed to read --included--; (E) on page 3, line 32, a comma should be inserted after “g.”; (F) on page 4, line 8, a comma should be inserted after “g.”; (G) on pages 5-7, the parenthetical references to the claims should be deleted since the claims may be renumbered when and if they are allowed; (H) on page 5, line 31, a comma should be inserted after “g.”; (I) on page 6, line 6, a comma should be inserted after “g.”; (J) on page 6, line 26, “said force . . . being between 100g and 150g” is an improper indication of the amount of force used since “g” refers to grams, i.e., a weight, and not the degree of force determined by the energy used ($E=mc^2$); (K) on page 8, line 8, “an” should read --a--; (L) on page 10, line 23, “visible on” should read --shown in--; (M) on page 10, lines 24-25, it is unclear as to what is intended by “said two noses”; (N) on page 10, line 25, “21” should read --21a--; (O) on page 10, line 32, “13” should read --21, 22--; (P) on page 10, line 36, either “100” should be deleted or --along main axis-- should be inserted before “100”; (Q) on page 11, line 2, “visible on” should read --shown in--, and a comma should be inserted after “21”; (R) on page 12, the sentence beginning on line 1 is confusing since “50” is used to designate not only the terminal part but also a stripe-shaped web; (S) on page 13, line 6, “63a” (both occurrences) should be changed to --62a--; (T) on page 13, line 19, “34” should read --35--; (U) on page 13, lines 36-37, it is unclear as to what structure the part 34 forms a part of; (V) on page on page 14, lines 8, 17 and 33, “10” should be deleted; (W) on page 14, line

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15, --part 17' of-- should be inserted after "extended", and 17' should be changed to --17--; and (X) on page 14, line 18, it is unclear as to what is intended by "corresponding lever arm". Appropriate correction is required.

18. The following informalities in the claims are noted: (A) in claim 1, on line 5, "being" should be changed to read --is--; (B) in claim 1, on line 6, "comprising" should read --defined by--; (C) in claim 1, line 7 contains "and" in italics (italics are only used in Reissue applications); (D) in claim 2, on line 1, --wherein-- should be inserted before "said", and "being" should be changed to read --is--; (E) in claim 6, on line 6, --said-- should be inserted before "two"; (F) in claim 7, on line 8, "comprising said main axis (100)" should be deleted; (G) in claim 8, on line 3, "comprising said main axis" should be deleted; (H) in claim 10, on line 2, the comma should be deleted; (I) in claim 13, on lines 1-2, "has a conical shape and" should be deleted since it is redundant; (J) in claim 14, on line 1, "claim 1" should be changed to read --claim 2--; (K) in claim 14, on line 5, "according to claim 2" should be deleted; (L) in claim 15, on line 1, "the introductory part of" should be deleted; (M) in claim 15, on line 3, a period should be inserted directly after "(100)" and "of the" should be deleted; (N) in claim 15, line 4 should be deleted in its entirety; (O) in claim 19, on line 3, a period should be inserted directly after "(100)" and "of the writing utensil or the" should be deleted; and (P) in claim 19, line 4 should be deleted in its entirety. Appropriate correction is required.

Election/Restrictions

19. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Elected*
- I. Figs. 1a, 1b, 1c, 2a and 2b;
 - III. Figs. 6a, 6b and 6c;
 - IV. Figs. 7a, 7b, 7c and 7d; and

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V. Figs. 8a and 8b.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To expedite prosecution, an action on the merits of the claims is given herein below.

Claim Objections

20. Claims 1-27 are objected to because of the following informalities: the claims are not in the proper format, i.e., each claim must be the object of a (grammatical) sentence. See MPEP § 608.01(m). Appropriate correction is required.

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21. Claim 14 and claim 18 which is dependent therefrom are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, claims 14 and 18 have not been further treated on the merits.

22. Claim 21 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim 21 has not been further treated on the merits.

23. Claim 27 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claim 27 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

24. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

25. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

26. Regarding claim 1, the phrase “controlled pivotable (inclinable)” renders the claim indefinite since it is unclear as to what is intended thereby.

27. Regarding claim 2, the phrase “particularly providing a longitudinal movement” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

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28. Claim 2 contains terms lacking proper antecedent basis. The claim recites the limitations “said inclination” in line 1, and “said tip” in line 5. There is insufficient antecedent basis for these limitations in the claim.

29. Regarding claim 3, the phrase “a refilling device as ink barrel” renders the claim indefinite since it is unclear as to what is intended thereby.

30. Claim 4 contains terms lacking proper antecedent basis. The claim recites the limitations “said tip” in lines 3 and 4-5, and “said adjustable inclination angle” in line 5. There is insufficient antecedent basis for these limitations in the claim.

31. Regarding claim 5, the phrase “particularly” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

32. Claim 5 contains terms lacking proper antecedent basis. The claim recites the limitations “said tip” in lines 1 and 6, and “the area” in line 4. There is insufficient antecedent basis for these limitations in the claim.

33. Regarding claim 6, the phrase “particularly” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

34. Claim 6 contains a term lacking proper antecedent basis. The claim recites the limitation “said connection” in line 7. There is insufficient antecedent basis for this limitation in the claim.

35. Regarding claim 7, the phrases “particularly” and “preferably” render the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention.

36. Claim 7 contains terms lacking proper antecedent basis. The claim recites the limitations “said pivoting direction” in line 3, “said controlled pivoting movement” in line 5, “said adjustment” in line 5, and “said tip” in line 6. There is insufficient antecedent basis for these limitations in the claim.

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37. Claim 8 contains a term lacking proper antecedent basis. The claim recites the limitation "said tip" in line 2. There is insufficient antecedent basis for this limitation in the claim.

38. Claim 8 is indefinite since it is unclear as to which "said portion" is being referred to on line 2 since two different portions have been recited, i.e., the coupling portion and the end portion.

39. Claim 9 contains a term lacking proper antecedent basis. The claim recites the limitation "said tip" in lines 2 and 4-5. There is insufficient antecedent basis for this limitation in the claim.

40. Regarding claim 10, the phrase "particularly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

41. Claim 10 contains terms lacking proper antecedent basis. The claim recites the limitations "said tip" in line 1, and "said conical tip" in line 5. There is insufficient antecedent basis for these limitations in the claim.

42. Regarding claim 11, the phrase "particularly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

43. Claim 11 contains terms lacking proper antecedent basis. The claim recites the limitations "said tip" in lines 1 and 2, "the front end" in line 2, and "the rear end" in line 3. There is insufficient antecedent basis for these limitations in the claim.

44. Regarding claim 12, the phrase "particularly" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

45. Claim 12 contains terms lacking proper antecedent basis. The claim recites the limitations "said tip" in lines 1, 2 and 2-3, "the length" in line 2, and "the rear end" in line 2. There is insufficient antecedent basis for these limitations in the claim.

46. Claim 13 contains a term lacking proper antecedent basis. The claim recites the limitation "said tip" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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47. Regarding claim 16, the phrase “particularly” renders these claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

48. Regarding claim 17, the phrase “particularly” (both instances) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

49. Claim 19 contains terms lacking proper antecedent basis. The claim recites the limitations “the kink angle” in line 1, and “the writing utensil” in line 3. There is insufficient antecedent basis for these limitations in the claim.

50. Claim 20 contains terms lacking proper antecedent basis. The claim recites the limitations “its backwards facing end portion” in line 2, “said refilling device” in line 3, and “said tip” in line 4. There is insufficient antecedent basis for these limitations in the claim.

51. Claim 22 contains a term lacking proper antecedent basis. The claim recites the limitation “said terminating part” in line 2. There is insufficient antecedent basis for this limitation in the claim.

52. Claim 24 contains a term lacking proper antecedent basis. The claim recites the limitation “said tip” in lines 3, 5 and 7. There is insufficient antecedent basis for this limitation in the claim.

53. Regarding claim 25, the phrase “such” (on line 3) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

54. Claim 25 contains terms lacking proper antecedent basis. The claim recites the limitations “said tip” in line 3 (both occurrences), and “said compression spring” in line 4. There is insufficient antecedent basis for these limitations in the claim.

55. Claim 26 contains terms lacking proper antecedent basis. The claim recites the limitations “said tip” in lines 2-3, and “said refilling device” in line 4. There is insufficient antecedent basis for these limitations in the claim.

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Claim Rejections - 35 USC § 102

56. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

57. Claims 1, 2, 5, 8, 10, 13/1, 15-17, 19, 20 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Garvey. Garvey discloses a writing or inscribing instrument having all the claimed features including a sleeve-shaped shaft A, a main axis (note the axis formed by parts A, C and B in Fig. 1), a terminal part at a rear end of the shaft A (note the top end of shaft A in Fig. 1), a substantially conical tip device (constituted by lower member B as shown in Fig. 1) at a front end portion of the shaft A which is controlled by the pressure applied to the tip (note lines 45-48 on page 2) and tiltable or pivotable or inclinable (note lines 36-38 on page 2) in a plane comprising the main axis and relative to the shaft A (note Fig. 5), and an inclination angle of a cone axis of the tip device B being adjustable in relation to the main axis (note Fig. 5 and lines 32-48 on page 2). With respect to claim 2, Garvey also discloses that the inclination angle is changed from the terminal part providing a longitudinal movement of the ink device constituted by the reservoir in shaft A (note Fig. 5 and line 67 on page 1) with the longitudinal movement being effected in a longitudinal direction and relative to a socket or bearing (constituted by the tip holder member C, stem 10 and valve 4) between the tip device B and the shaft A. With respect to claim 5, Garvey additionally discloses that the tip device is pivotally received at a bearing portion (constituted by stem 10) at the shaft A (note Fig. 5) and the bearing portion 10 also constitutes a pivoting axis for varying the inclination angle of the tip device. With respect to claim 8, Garvey further discloses a coupling portion (constituted by valve 4) provided at an end portion of the tip device which is offset, i.e., perpendicular, in relation to the bearing portion 10 in the plane of the main axis of shaft A. With regard to claim 10, Garvey

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also discloses that the tip device has a limiting means (constituted by the inwardly projecting portions of valve housing 1 which define discharge opening 3) for limiting maximum inclination portions by contacting protrusions (the portions defining opening 3) which form a guiding means located at the inside of said shaft A. With regard to claim 13/1, Garvey further discloses that the conical tip device B is symmetrical with respect to a cone axis (note Fig. 1). With regard to claim 15, Garvey additionally discloses that the tip device B is elongated in shape and has a cone axis variable in its angle relative to the main axis (note Figs. 1, 2 and 5). With respect to claim 16, Garvey also discloses that the tip device B has a rear end portion cooperating with a shoulder portion constituted by the widened outer flange portion thereof (note Figs. 1, 2 and 5). With respect to claim 17, Garvey further discloses that the tip device is provided with a control means (inherently constituted by the cooperation of the widened outer flange portion of valve housing 1, the smaller diameter portion of valve housing 1, and the member C (as shown in Fig. 5)) having two web portions (constituted by the widened outer flange portion of valve housing 1 and the smaller diameter portion of valve housing 1) extending to form an angle of less than 180° for controlling the inclination of the tip device. With regard to claim 19, Garvey also inherently discloses that the angle of less than 180° for controlling the inclination of the tip device substantially corresponds to a maximum inclination angle of the tip device relative to the main axis of the shaft A (note Fig. 5). With regard to claim 20, Garvey additionally discloses that the tip device is provided with a coupling means (constituted by valve housing 1) at its backwards facing end portion (note Figs. 2 and 5) and a shoulder of a refilling device (constituted by the reservoir formed by shaft A) being coupled to the coupling means; the functional recitations of intended use have been carefully considered but are deemed not to impose any structural limitations on the claim distinguishable over that shown by Garvey which is certainly capable of being used in the intended manner if one desires to do so. With regard to claim 26, Garvey further discloses a means for controlling and adjusting the inclination

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angle (note lines 45-48 on page 2) and another means constituted by extension 2 for permitting an opening of the writing instrument.

58. Claims 1, 2, 11-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganter (German Patent '614). Ganter discloses a writing instrument having all the claimed features including a sleeve-shaped shaft b, a main axis (note the axis formed by shaft b), a terminal part at a rear end of the shaft b (constituted by the end of shaft b opposite to the writing tip a), a substantially conical tip device (constituted by the lower end of writing tip a) at a front end portion of the shaft b which is controlled by the joint c and the nut d and pivotable or inclinable in a plane comprising the main axis and relative to the shaft b, and an inclination angle of a cone axis of the tip device a being adjustable in relation to the main axis. With respect to claim 2, Ganter also discloses that the inclination angle is changed from the terminal part providing a longitudinal movement of the ink device constituted by the reservoir in shaft b with the longitudinal movement being effected in a longitudinal direction and relative to a socket or bearing (constituted by the joint c) between the tip device a and the shaft b. With respect to claim 11, Ganter further discloses that the tip a is received at the inside and at the front end of the shaft b; although Ganter fails to describe how the tip a is inserted into the shaft b, it appears that the tip a is inherently inserted into the shaft b from the rear end thereof in order for the joint c to be located within the shaft b. With regard to claim 12, Ganter additionally discloses that the tip a has an elongated extension, the length of which is larger than a diameter at the rear end of the tip a. With regard to claim 13, Ganter also discloses that the tip a has a conical shape at its outer end and is adapted to be symmetrical with respect to the cone axis. With regard to claim 15, Ganter additionally discloses that the tip device a is elongated in shape and has a cone axis variable in its angle relative to the main axis.

59. Claims 1, 3, 4, 15, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bacou (French patent '384). Bacou discloses a writing instrument having all the claimed features

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including a sleeve-shaped shaft or body 12, a main axis (note the axis formed by shaft 12), a terminal part at a rear end of the shaft 12 (constituted by the end adjacent the cover 13), a substantially conical tip device (constituted by the end of shaft 12 at writing tip 9) at a front end portion of the shaft 12 which is controlled by the material forming junction 11 and pivotable or inclinable in a plane comprising the main axis and relative to the shaft 12, and an inclination angle of a cone axis $x'-x$ (note Fig. 1) of the tip device being adjustable in relation to the main axis. With respect to claim 3, Bacou also discloses a refilling device constituted by cartridge 8 comprising an elastically flexible portion (constituted by the material forming junction 11) at a front end thereof, the elastically flexible portion being able to change its deflection, particularly its bending stress, upon changing the inclination angle. With regard to claim 4, Bacou further discloses that the elastically flexible portion 11 is at its front end and is adapted as a writing tip 9, the tip 9 protruding through a front end opening of the tip (note Figs. 1-5) to make use of the bending stress of the elastically flexible portion for effecting a returning force on the tip 9 having the adjustable inclination angle. With regard to claim 15, Bacou additionally discloses that the tip device is elongated in shape and has a cone axis $x'-x$ variable in its angle relative to the main axis. With respect to claim 23, Bacou also discloses that a length of the shaft 12 and the writing instrument is for varying the inclination angle of the tip device. With respect to claim 26, Bacou further discloses a means for controlling and adjusting the inclination angle of the tip (constituted by the type of material forming the elastically flexible portion) and, independently thereof, a further means constituted by cover 13 for permitting an opening of the writing instrument to exchange the refilling device 8.

Claim Rejections - 35 USC § 103

60. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

61. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bacou in view of Malm. With respect to claim 24, although Bacou fails to disclose that the refilling device 8 is tensioned by a compression or pressure spring, attention is directed to Malm who discloses another ball point pen having a pressure control assembly including a pressure spring 60 for urging the refilling device against the tip with the pressure spring being dimensioned such that it receives/absorbs writing forces without substantially changing the position of the refilling device but effects a smaller torque on the tip than a returning force of a further elastic means, constituted by the spring 5, coupled to the tip (note lines 21-24 in col. 3) in order to economically attain a dependable instrument capable of continued writing on vertical surfaces without changes in ink characteristics or other troublesome and expensive deviations (note from line 63 in col. 1 to line 2 in col. 2). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to provide the ball point pen of Bacou with a pressure control assembly including pressure springs in view of the teaching of Malm in order to economically attain a dependable instrument capable of continued writing on vertical surfaces without changes in ink characteristics or other troublesome and expensive deviations. With respect to claim 25, Malm further teaches the obviousness of elastically tensioning the refilling device in relation to the tip and a second elastic force constituted by spring 5 being applied on the tip (note Fig. 1) and dimensioned such that a torque applied by the spring 60 is at least compensated (note lines 58-70 in col. 4) in order to economically attain a dependable instrument capable of continued writing on vertical surfaces without changes in ink characteristics or other troublesome and expensive deviations (note from line 63 in col. 1 to line 2 in col. 2).

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62. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garvey. Although Garvey fails to disclose that the shaft A can be varied in length, to vary the length of the shaft A of Garvey by using differently sized reservoirs would be an obvious expedient to the artisan skilled in the writing instrument art depending upon the size of ink reservoir to be used for a particular purpose, such as when different colored inks are to be used, and that can be comfortably held by the user while writing.

Allowable Subject Matter

63. Claims 6, 7 and 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

64. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

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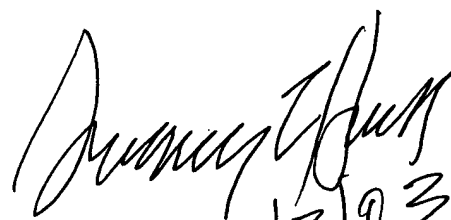
65. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.


Kathleen J. Prunner:kjp

March 3, 2003


3/3/03

GREGORY HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700